

REMARKS

This Application has been carefully reviewed in light of the Office Action. Claims 1-23 are pending in the Application. The Office Action rejects Claims 1-23. Applicants respectfully request reconsideration and favorable action in this case.

Section 103 Rejections

The Office Action rejects Claims 1, 3-13, 15, 17-18, and 21-23 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,673,701 to Chance (“*Chance*”) in view of U.S. Patent 5,987,346 to Benaron et al. (“*Benaron*”). The Office Action further rejects Claims 2, 16, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over at least *Chance* and *Benaron*. Applicants respectfully traverse these rejections for the reasons stated below.

Independent Claim 1 is allowable at least because the combination of *Chance* and *Benaron* proposed in the Office Action fails to disclose, expressly or inherently, “imaging the lymph node of the lymphatic system.” The Office Action concedes that *Chance* fails to disclose this limitation. *See Office Action*, Page 2 (stating “*Chance* fails to disclose . . . imaging [a] lymph node.”). Instead, the Office Action contends that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Chance* using the disclosure of *Benaron* in order to disclose this limitation. *See Office Action*, Page 2. This, however, is incorrect. For example, modifying *Chance* using the disclosure of *Benaron* would render *Chance* unsatisfactory for its intended purpose—thus, “there is no suggestion or motivation to make the proposed modification.” *See M.P.E.P. § 2143.01(V)* (stating “[if] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”).

In particular, *Chance* discloses that when imaging a biological tissue with a fluorescent constituent, intensity modulated radiation is used to excite the fluorescent constituent so that “a fluorescent radiation of a different wavelength is re-emitted” from the fluorescent constituent. *See Chance*, Col. 11, Lines 59-64. According to *Chance*, it is this “re-emitted radiation [that] is detected using detector systems.” *See Chance*, Col. 12, Lines 27-36. On the other hand, *Benaron* clearly discloses that in order to detect lymph nodes, light is passed through the lymph nodes, and this light, which now bears “a signature of the tissue

through which it passed,” is analyzed.” *See Benaron*, Col. 1, Lines 44-49. Thus, in order to detect lymph nodes, *Benaron* uses a method that does not excite a fluorescent constituent or measure the re-emitted radiation from a fluorescent constituent—each of which is essential to the method of *Chance*. As a result, modifying *Chance* using *Benaron* would render *Chance* unsatisfactory for its intended purpose. Accordingly, as stated in the M.P.E.P., “there is no suggestion or motivation to make the proposed modification.” *See* M.P.E.P. § 2143.01(V).

Furthermore, Applicants also point out that *Benaron* mentions that methods of “utiliz[ing] fluorescence or other emission-based techniques which measure light other than that used to perform the illumination” are already known in the art. *See Benaron*, Col. 1, Lines 49-60. In doing so, *Benaron* discloses that these methods are not satisfactory for its method of detecting lymph nodes.

Consequently, the combination of *Chance* and *Benaron* proposed in the Office Action fails to disclose, expressly or inherently, the limitations of Independent Claim 1. For at least this reason, Independent Claim 1 is allowable, as are Claims 2-6 that depend therefrom. For analogous reasons, Independent Claims 7, 15, and 21 are allowable, as are Claims 8-14, 16-20, and 22-23 that depend therefrom. Reconsideration and favorable action are requested.

Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicants respectfully request full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants take a one-month extension of time from July 3, 2008 to August 3, 2008. The Commissioner is hereby authorized to charge the one-month extension fee in the amount of \$60.00 and any other required fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTT S L.L.P.
Attorneys for Applicants

Bradley P. Williams
Reg. No. 40,227
PHONE: (214) 953-6447

Date: August 4, 2008

Customer Number: 05073